

## REMARKS

### Request for Reconsideration

Applicants have carefully considered the matters raised by the Examiner in the outstanding Office Action but remain of the opinion that patentable subject matter is present. Applicants respectfully request reconsideration of the Examiner's position based on the above amendments to the Specification and Claims and the following remarks.

### Claims Status

Claims 1, 5-11, 13, 18, and 21-27 are pending in this Application.

Claims 12, 14-17, 19 and 20 have been canceled herein.

Claims 1 and 21 have been amended and Claim 27 is new.

Claims 1 and 21 have been amended herein to recite a fixing step. Support for the fixing step can be found on page 9, lines 2-4.

Claims 1 and 21 have also been amended herein to recite reusing of the non-transferred toner. Support for this limitation can be found on page 1, in the first paragraph; page 62, lines 1-3; and page 10, line 6 through page 14, line 18.

Claim 21 has also been amended herein to recite that the collected non-transferred toner is passed through a toner intermediate chamber with a gas. Support for this limitation can be found on page 11, lines 10-15; and page 12, lines 20-22.

New Claim 27 recites that the releasing agent has a melting point in the range of 40 to 150°C. Support for this limitation can be found on page 33, lines 11-17.

Claims 1 and 21 have also been amended herein to correct some obvious typographical errors.

Respectfully, no new matter has been added by way of these amendments.

### **Specification Objections and Amendments**

The Examiner had objected to the Specification and, specifically, to the amendment made on page 15 on the basis that the amendment contained new matter, see item 3 on page 4 of the Office Action. The Examiner had required the Applicant to cancel the new matter in reply to the Office Action. Applicants have amended the third paragraph on page 15 to revert to the original wording, thereby canceling the matter objected to by the Examiner.

### **Rejection Under 35 USC 112, second paragraph:**

The Examiner had rejected Claims 1, 5-13 and 16-19 under 35 USC 112, second paragraph, as being indefinite. The Examiner has specifically cited to the passage in Claim 1, "of the toner particles".

In response to the Examiner's rejection, Applicants have amended Claim 1 to remove the word "of" and a comma has been inserted. Respectfully, Claim 1 is now definite as well as its dependent claims.

**Rejection Under 35 USC 112, first paragraph:**

Claims 1, 5-14, 16-19 and 21-26 have been rejected under 35 USC 112, first paragraph, for failing to comply with the written description requirement.

The Examiner had rejected Claim 1 on the basis that the description required that the intermediate chamber be defined as "situated in the vertical direction". In response to this rejection, Claim 1 has been amended herein to recite that the intermediate chamber is "oriented in a vertical direction". It is respectfully submitted that such an amendment overcomes the rejection to Claim 1.

Claims 5, 6, 7, 14, 21, 22 and 23-26 had been rejected because the claims recited "amorphous polyester" while the definition of "amorphous polyester" had been amended in the Specification on page 15. That amendment had been objected to as entering new matter.

Based on the amendments made to the Specification at page 15, it is deemed that the rejection to these claims has now been overcome.

Claim 12 had been objected to because of an extraneous comma. As noted above, Claim 12 has been canceled herein.

### Prior Art Rejection

The Examiner put forward the following three Prior Art rejections:

(1) Claims 14, 21 and 23-26 had been rejected as being unpatentable over a combination of JP '813, Ohmura, Matsushima '647 and Hayashi;

(2) Claims 1, 8-13, and 16-19 had been rejected as being unpatentable over a combination of Taffler and Ohmura; and

(3) Claim 5 had been rejected as being unpatentable over a combination of Taffler, Ohmura, Matsushima '647 and Hayashi.

In the previous Office Action, Applicants had submitted a Certified Copy of the Priority Document so as to remove Ohmura and Matsushima as Prior Art. In response to this Submission, the Examiner had pointed out that the Priority Document recites a fixing step and a reusing step of the non-transferred toner, while the independent Claims,

Claim 1 and 21, did not recite these two steps. As noted above, Claims 1 and 21 have been amended herein to add both a fixing step and a reusing step.

Claim 21 had also been objected to as not requiring that a gas be included in the step of passing the collected non-transferred toner through the toner intermediate chamber. Claim 21 has been amended herein to add that the passing is with gas and, thus, it is submitted that this aspect of Claim 21 is fully supported now by the Priority Document.

The Examiner had also noted that the Translation of the Priority Document requires that the intermediate chamber be situated in a vertical direction. Claims 1 and 21 have both been amended herein to recite the intermediate chamber is oriented in a vertical direction.

The Examiner had pointed to the fact that the Translation did not support the amorphous polyester resin as defined in amended paragraph 3, page 15. Paragraph 3 of page 15 has been amended to put it back into its original wording and, thus, it is respectfully submitted that it is clearly supported by the Priority Document.

Claims 12, 16 and 17 had been objected to as not being supported by the Priority Document. It should be noted that Claims 12, 16 and 17 have been canceled herein.

It is respectfully submitted now that the Priority Document clearly supports independent Claims 1 and 21 as well as the dependent claims thereon and, thus, Ohmura and Matsushima are not Prior Art to the claims as presented herein.

In view of the foregoing, it is respectfully submitted that the claims, as presented herein, are patentable over the references taken alone or in combination.

**Request for Two-Month Extension of Time**

Applicants hereby petition for a two month extension of time within which to respond to the outstanding Office Action and, in that vein, the fee associated with the two month extension is paid herewith.

Should any additional fees or extensions of time be necessary in order to maintain this Application in pending condition, appropriate requests are hereby made and authorization is given to Debit Account #02-2275.

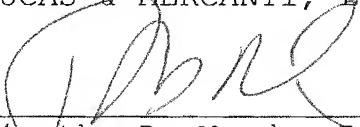
Conclusion

In view of the foregoing, it is respectfully submitted that the Application is in condition for allowance and such action is respectfully requested.

Respectfully submitted,

LUCAS & MERCANTI, LLP

By:

  
Timothy D. Meade, Reg. #55,449  
(Attorney for Applicant)  
475 Park Avenue South  
New York, New York 10016  
Tel. # (212) 661-8000

DCL/mr